

# Notice of Allowability

Application No.

10/037,110

Examiner

Thomas McKenzie, Ph.D.

Applicant(s)

CALDIROLA ET AL.

Art Unit

1624

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE, amendments, and declaration of 11/28/05.
2. ☒ The allowed claim(s) is/are 1-3,6-12,15-17,22,24,28-30,32-34,36-38,41-44,46-48,50,54-56 and 59-100.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 2/03,3/02&11/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☐ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

  
Thomas C. McKenzie, Ph.D.  
Primary Examiner  
Art Unit 1624

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/28/05 has been entered.

***Statement of Reasons for Allowance***

2. Claims 1-3,6-12,15-17,22,24,28-30,32-34,36-38,41-44,46-48,50,54-56 and 59-100 are allowed. The following is an Examiner's statement of reasons for allowance: the declaration by Dr. Caldirola under 37 CFR 1.132 filed 11/28/05 is sufficient to overcome the rejection of claims 1-3, 11, 12, 22, 28-30, 33, 34, 36-38, 44, 46-48, 54, 55, 59, and 60 based upon obviousness over Isaac (Bioorganic & Medicinal Chemistry Letters, Ref ADD) made in point #7 of the previous Final Rejection. While not the best comparison, for the compounds used by Applicants differ in the structure of both Ar and R<sup>4</sup> from the species taught by Isaac (Bioorganic & Medicinal Chemistry Letters, Ref ADD), the compound taught by the reference is inactive in the *in vivo* feeding test in mice used by Applicants. While the compound of Isaac (Bioorganic & Medicinal Chemistry Letters, Ref ADD) does cause some decrease in the food intake after treatment with the

compound, this decrease is less than that of saline control alone. This lack of effect in the feeding test by compound **4a** is in marked contrast to the effect induced by Applicants compounds. Applicants' compounds cause a dose-related decrease in food intake relative to saline control. This is a clear difference in kind not some subtle difference in degree in the *in vivo* efficacy of Applicants' claimed isomers. Such a complete lack of activity in the species taught by the reference would discourage any medicinal chemist from preparing ring position isomers of that species.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

3. Information regarding the status of an application should be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). All


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Post-Allowance correspondence concerning this application must be mailed to the following address:

Box Issue Fee  
Commissioner for Patents  
Washington, DC 20231.

Such correspondence (amendments under 37 CFR 1.312, IDS statements, formal drawings etc) also may be faxed to the Office of Patent Publications at (703) 308-5083. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

  
Thomas C. McKenzie, Ph.D.  
Primary Examiner  
Art Unit 1624

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